

REMARKS

1. Status of the Claims

The Applicant has reviewed and considered the non-final Office Action mailed on January 19, 2005, and the references cited therewith.

In the Office Action, claims 1-20 are pending. Claims 1-19 are rejected by the Examiner. Claim 20 is objected to by the Examiner. Further, the drawings are objected to by the Examiner. Claims 1, 3, 8, 11, 13 and 18 are amended. Claims 2, 7, 12 and 17 are cancelled. The drawings have been amended. As a result, claims 1, 3-6, 8-11, 13-16 and 18-20 are now pending in this application.

The Applicant respectfully requests reconsideration of the above-identified patent application as amended and in view of the following remarks.

2. Objection under 37 C.F.R. § 1.83(a)

The drawings have been objected to under 37 C.F.R. 1.83(a). More specifically, the drawings were objected to because it is asserted that they fail to show (1) the extension members; (2) the plate; (3) the repositioning means; and (4) the removing means.

As to the objection over the drawings failing to show the extension members, in order to expedite the substantive examination of the present invention, and without prejudice, the Applicant has cancelled claims 7 and 17 to render this objection moot.

As to the objection over the drawings failing to show the plate, the Applicant respectfully disagrees and submits that the plate is shown. As is defined in the Specification that “[i]n a preferred embodiment, the securement means is a vacuum plate which includes plate 11 and an integral vacuum assembly.” See *Specification*, page 8, lines 9-14. As can be seen in Figures 1-9, plate 11 is a vacuum plate which includes plate 11 and an integral vacuum assembly. In other

words, the plate 11 as shown in Figures 1-9 is one of the preferred embodiments of the present invention, which is representative of the vacuum plate as contemplated in the specification of the present invention. Thus, the Applicant submits that the “the plate 11” claimed in the present invention is shown adequately in the drawings; and 37 C.F.R. 1.83(a) is, therefore, complied with.

As to the objection over the drawings failing to show the repositioning means, the Applicant respectfully disagrees and submits that the repositioning means is shown. As is defined in the Specification, “[r]epositioning means 36, as shown in Fig. 6, repositions clamp [16] from one position to a second position in more than one plane. The repositioning means is also associated with clamp 16 and rotation means 20. It is contemplated that the repositioning means is any conventional structure which moves an element from a first position to a second position in more than one plane, as would be readily understood to those having ordinary skill in the art.” See *Specification*, page 9, lines 18-22. As can be seen in Figs. 6-9, the repositioning means is labeled as element 36. The repositioning means is schematically shown in Figs. 6-9, and this is representative of the repositioning means as contemplated in the specification of the present invention. Thus, the Applicant submits that the repositioning means claimed in the present invention is shown adequately in the drawings; and 37 C.F.R. 1.83(a) is, therefore, complied with.

As to the removing means, the Applicant has amended the Figs. 13 and 14 to show the removing means. As shown in the amended Figs. 13 and 14, the removing means is labeled as element 47. As defined in the Specification, “the resulting battery has portions of the active material removed at folded portions via a removing means which removes the active material from a surface of the folded portions. The removing means may comprise a laser, a solvent, or

any other means of removing the active material from the electrode sheet.” See Specification, page 13, lines 19-21 and page 14, line 1. The amendments to Figs. 13 and 14 are fully supported by the specification and thus no new matter has been added. The attached sheet of drawing includes changes to Figs. 13 and 14. This sheet, which includes Figs. 13 and 14, replaces the original sheet including Figs. 13 and 14.

Based on the above, the Applicant submits that the Office’s objections to the drawings have been overcome, and respectfully requests that the Office withdraw the objections.

3. Rejections under 35 U.S.C. § 112

Claims 2, 5, 6, 10, 12, 15 and 16 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 2, 5, 6, 10, 12, 15 and 16, the Examiner asserts that, in short, no disclosure can be found of the “extension members;” no construction of the “removing means” in conjunction with the folding apparatus; and no clear distinction of the “repositioning means” from the sliding means, as shown in figure 6. *Office Action*, page 4.

The Applicant respectfully traverses these assertions. The Applicant understands that “to comply with the description requirement of 35 U.S.C. § 112, first paragraph ...; all that is required is that the application reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him; *Forssmann v. Matsuo*, 23 U.S.P.Q. 2d 1548, 1550 (B.P.A.I. 1992), *aff’d*, 991 F.2d 809 (Fed. Cir. 1993). The Applicant further understands that “[i]f a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing,

even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met,” *In re Alton*, 37 U.S.P.Q. 2d 1578, 1584 (Fed. Cir. 1996).

“Adequate description under the first paragraph of 35 U.S.C. § 112 does not require literal support for the claimed invention Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed,” *Ex parte Parks*, 30 U.S.P.Q.2d 1234, 1236-37 (B.P.A.I. 1993). “If, on the other hand, the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *Id.* at 264, 191 U.S.P.Q.2d 1578, 1583 (Fed. Cir. 1996).

With respect to claims 2 and 12, the rejection is moot because these claims have been canceled.

With respect to the “removing means,” the Applicant respectfully submits that a construction of the moving means in conjunction with the folding apparatus is described in the specification and now amended Figs. 13 and 14, in such a way as to reasonably convey to one of ordinary skill in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. When read in view of the other embodiments described in the specification and in view of now amended Figs. 13 and 14, the construction of the removing means in conjunction with the folding apparatus is inherently described. That is, one of skill in the art, knowing that the removing means comprise a laser, a solvent, or any other means of removing the active material from the electrode sheet (*application*, page 13, lines 20-21), could

configure the assembly of the removing means as claimed. Therefore reversal of this rejection is respectfully requested.

With respect to the “repositioning means,” the Applicant further submits that the specification described having the repositioning means “repositions clamp [16] from one position to a second position in more than one plane.” (*Application*, page 9, lines 18-1900). Therefore, it is inherent from the specification and figure 6 as originally filed, especially to one ordinary skill in the art, that the embodiment of figure 6, having both the sliding means and the repositioning means associated with clamp 6 and rotation means 20, would be readily understood. Therefore reversal of this rejection is respectfully requested.

Claims 7, 8 and 17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In order to expedite the prosecution, claims 7 and 17 have been cancelled, without prejudice, rendering this rejection moot. Further, claim 8 has been amended to correct antecedent basis for the “secured” and “unsecured.”

These amendments are made only for the sake of clarity and not to distinguish the claimed invention over any prior art references. Further, they introduce no new matter. Reconsideration and reversal of these rejections are respectfully requested.

4. Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4-6, 8, 9, 11, 12, 14-16, 18 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Delachartre (U.S. Patent No. 671,312). Claims 1 and 11 have been amended to incorporate the substance of claims 7 and 17, respectively. Accordingly, claim 1 is directed to an apparatus further including “means for returning the sheet to the at least one of the

first rotational position and second rotational position to form an additional folded portion.” Further, claim 11 claims a method of providing the step of “returning the sheet to the at least one of the first rotational position and second rotational position to form an additional folded portion.” Since a rejection under 35 U.S.C. § 102(b) requires that the cited reference (a single reference) teaches or enables each and every claim limitation expressly or inherently as interpreted by one of ordinary skill in the art, the Applicant asserts that Delachartre does not anticipate claims 1 and 11. The Applicant further submits that dependent claims 4-6, 8, 9, 12, 14-16, 18-19 are not anticipated as they contain additional limitations to independent claims 1 and 11 as amended. For these reasons, the Applicant submits that claims 1, 4-6, 8, 9, 11, 12, 14-16, 18-19 are patentable over Delachartre.

5. Rejections Under 35 U.S.C. § 103

Claims 3 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Delachartre in view of Takeuchi (U.S. Patent No. 4,594,868). Claims 3 and 13 depend from independent claim 1 and 11 respectively. Claims 1 and 11 have been amended as noted above. Thus, the cited references do not teach each and every claim limitation. Since a *prima facie* case of obviousness requires that the references teach or suggest each and every element of the claimed invention (see MPEP § 2143), the Applicant respectfully submits that claims 3 and 13 are patentable over Delachartre in view of Takeuchi. For these and other reasons, the Applicant submits that claims 3 and 13 are in condition for allowance.

6. Allowable Subject Matter

The Applicant notes with appreciation the Examiner’s indication that claim 20 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Notwithstanding, the base claim 11 has been amended rendering this

objection moot. Thus, reconsideration and withdrawal of the objection as the Office applies to claim 20 is requested.

7. Conclusion

For these and other reasons, the Applicant respectfully submits that the pending claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorneys (312) 226-1818 to facilitate prosecute of this application.

Respectfully submitted,

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Dated: July 19, 2005



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Patent Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 19, 2005.

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Name of Applicant, assignee, applicant's attorney or Registered Representative


Signature